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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,016	05/31/2005	Dong-Hyun Kim	7260P001	8746

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EXAMINER	
CLARK, AMY LYNN	

ART UNIT	PAPER NUMBER
1655	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/511,016	KIM ET AL.	
	Examiner	Art Unit	
	Amy L. Clark	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-12* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-7 and 9, drawn to a pharmaceutical composition comprising processed ginseng extract and a pharmaceutically acceptable carrier.

Group II, claim 8, drawn to a pharmaceutical composition comprising saponin compounds as an active ingredient and a pharmaceutically acceptable carrier.

Group III, claim(s) 10, drawn to a use of ginseng extract in the preparation of the medicament to prevent or treat brain stroke and brain diseases.

Group IV, claim(s) 11 and 12, drawn to a health care food comprising an extract of ginseng and a sitologically acceptable additive.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature of Group I is a pharmaceutical composition comprising processed ginseng extract and a pharmaceutically acceptable carrier and is not required for Group II, which is drawn to a pharmaceutical composition comprising saponin compounds as an active ingredient and a pharmaceutically acceptable carrier, nor is the Invention of Group I required for Group III, which is drawn to a use of ginseng extract in the preparation of the medicament to prevent or treat brain stroke and brain diseases, nor is the Invention of Group I required for Group IV, which is drawn to a

health care food comprising an extract of ginseng and a sitologically acceptable additive. Furthermore, Claim 1, at least, lacks novelty or an invention step as taught Yuchi et al. (N, Japanese Patent Number 60-037960). Yuchi teaches a health drink to eliminate the side effect of adrenocortical hormones comprising saponins extracted from Panax ginseng and brown rice vinegar. Please note that Claim 1 constitutes a Product-by-Process type claim. In Product-by-Process type claims, the process of producing the product is given no patentable weight since it does not impart novelty to a product when the product is taught by the prior art. See *In re Thorpe*, 227 USPQ 964 (CAFC 1985); *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983) and *In re Brown*, 173 USPQ 685 (CCPA 1972). Consequently, even if a particular process used to prepare a product is novel and unobvious over the prior art, the product *per se*, even when limited to the particular process, is unpatentable over the same product taught in by the prior art. See *In re King*, 107 F.2d 618, 620, 43 USPQ 400, 402 (CCPA 1939); *In re Merz*, 97 F.2d 599, 601, 38 USPQ 143-145 (CCPA 1938); *In re Bergy*, 563 F.2d 1031, 1035, 195 USPQ 344, 348 (CCPA 1977) *vacated* 438 US 902 (1978); and *United States v. Ciba-Geigy Corp.*, 508 F. Supp. 1157, 1171, 211 USPQ 529, 543 (DNJ 1979). Finally, since the Patent Office does not have the facilities for examining and comparing Applicant's composition with the compositions of the prior art reference, the burden is upon Applicant to show a distinction between the material, structural and functional characteristics of the claimed composition and the composition of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). Therefore, a pharmaceutical

composition comprising processed ginseng extract and a pharmaceutically acceptable carrier is not a contribution over the prior art.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group I:

Specie A: elect either lactic-acid bacteria or intestinal bacterial from Claim 1.

If lactic acid bacteria is elected from Claim 1 as Specie A, further elect one or more types of lactic acid bacteria from either Claim 4 or Claim 5.

If intestinal bacteria is elected from Claim 1 as Specie A, further elect one or more intestinal bacteria from Claim 6 or Claim 7.

Specie B: elect one acid from Claim 3.

Specie C: elect one carrier from Claim 9.

Group II:

Specie A: elect one or more saponin compounds from Claim 8.

Group III:

Specie A: elect either lactic-acid bacteria or intestinal bacterial from Claim 10.

Group IV:

Specie A: elect either lactic-acid bacteria or intestinal bacterial.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Group I:

Specie A: If lactic acid bacteria is elected from Claim 1 as Specie A, Claims 1-5 and 9 read on the elected specie.

If intestinal bacteria is elected from Claim 1 as Specie A, Claims 1-3, 6, 7 and 9 read on the elected specie.

Specie B: Claim 3 reads on the elected specie.

Specie C: Claim 9 reads on the elected specie.

Group II:

Specie A: Claim 8 reads on the elected specie.

Group III:

Specie A: Claim 10 reads on the elected specie.

Group IV:

Specie A: Claims 11 and 12 read on the elected specie.

The following claims are generic: Claims 1, 8, 10 and 11 are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The species do not related to a single general inventive concept because the types of bacteria in Claims 1, 4-7, 10 and 11, the acids listed in Claim 3, the saponin compounds listed in Claim 8 and the carriers listed in Claim 9 are distinct both physically and functionally from each other both within each Claim and between the Claims. And a search for one type of bacteria, acid, saponin compound and carrier is not co-extensive with a search for another.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark
AU 1655

Amy L. Clark
June 29, 2006

MICHELE FLOOD
PRIMARY EXAMINER